REMARKS

Following entry of the present amendment, Claims 1-14, 17-24 and 27-29 remain in the application for consideration. Claims 15 and 16 were withdrawn and are herein cancelled without prejudice. Applicants herein reserve their right to file divisional applications on claims 15 and 16 pursuant to 35 U.S.C. §120. Claims 25 and 26 are herein cancelled without prejudice.

In the present Office Action, claims 1, 2, 5-14, and 19-29 stand rejected. Claims 3, 4, 17, and 18 stand objected to. Claims 23 and 29 are are herein amended.

Rejections Under 35 USC §112

Claims 23, 24, and 28 were rejected under 35 U.S.C. §112, first paragraph, because the specification allegedly does not provide enablement for an agent which prevents or inhibits diseases associated with metabolism dysfunction through the use of the composition.

To address the rejection, Applicants herein delete "preventing" and "inhibiting" from Claim 23. Applicants now submit that amended Claim 23, and Claims 24 and 28 depending therefrom, are fully supported in the specification. Therefore, Applicants' submit that this rejection is overcome.

Rejections under 35 U.S.C §101

Claims 25, 26, and 29 were rejected under 35 U.S.C. §101 because the claims are directed to non-statutory subject matter. Specifically, the aforementioned claims were drafted in terms of

"use." However, the Examiner indicated that "use" is not one of the statutory classes of invention.

To address this rejection, Applicants herein cancel Claims 25 and 26 without prejudice, and amend Claim 29 to recite a method to treat skin disorder or disease comprising the step of administering to a patient a therapeutically effective amount of a compound of Claim 1 in combination with a retinoid or a vitamin D analog. Applicants respectfully submit that this rejection is now overcome.

35 U.S.C. §101 Double-Patenting Rejection

The Examiner rejected Claims 1, 2, 5-14 and 19-29 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-10, 12-15, and 17-23 of U.S. Patent No. 6,395,784. Applicants respectfully traverse this rejection.

Applicants submit that under 37 CFR 1.130(b), when an application claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double-patenting rejection will be made in the application. Applicants respectfully point out that common ownership of the cited patent and the patent application is required under 37 CFR 1.130(b).

U.S. Patent No. 6,395,784 ('784 patent), issued on May 28, 2002, has been assigned to Bristol-Myers Squibb as evidenced on the face of the patent. In contrast, the present application has been assigned to Karo Bio AB as shown on a copy of the Assignment recorded at reel 012165, frame 0429 (copy enclosed). Applicants submit that since the '784 patent and the present application are not commonly owned as required by 37 CFR

§1.130(b), this obviousness-type double patenting rejection is improper and should be withdrawn.

Claim Objections

Claims 3, 4, 17, and 18 were objected to as being dependent on rejected base Claims. Applicants respectfully submit that Claims 3, 4, 17, and 18 are properly dependent on base Claims that Applicants believe are now allowable. Accordingly, Applicants submit that these objections are traversed.

Applicants now submit that the claims are in condition for allowance, and respectfully request reconsideration and issuance of a timely Notice of Allowance.

If the Examiner has any questions or feels that a discussion with Applicants' representative would expedite prosecution, the Examiner is invited and encouraged to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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